

DOCKET NO: 205279US3X



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF

KATSUYUKI SUZUKI, ET AL.

SERIAL NO: 09/821,069

FILED: MARCH 30, 2001

FOR: HOLE FORMING TOOL

:

: EXAMINER: PIERCE, W.

: GROUP ART UNIT: 3711

: RCE FILED: MAY 2, 2005

:

TRANSMITTAL OF PETITION UNDER 37 C.F.R. § 1.181

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

SIR:

Attached is a Petition Under 37 C.F.R. § 1.181.

Although Applicants believe that no fees are due, please charge any fees, and credit any refunds, associated with this petition to deposit account number 15-0030. A duplicate copy of this sheet is attached.

Respectfully submitted,

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PETITION UNDER 37 C.F.R. § 1.181

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicants respectfully petition that the finality of the Final Rejection dated August 11, 2005, be withdrawn, because the Final Rejection was improperly made as the first Office action following an Amendment that added a previously unexamined limitation to the claims.

An Amendment and Request for Withdrawal of Finality of Final Rejection was filed on December 30, 2005. However, the Advisory Action dated February 7, 2006, improperly maintained the Final Rejection.

The Final Rejection was made in response to the Amendment filed, with a Request for Continued Examination, on May 2, 2005. The Amendment added to independent Claims 1, 4, 6-7, 11 and 16-22 the previously unexamined limitation that "said core diameter is a diameter of a solid core of material extending out of said one or more chip discharging grooves". Support for this limitation is found, not in the claims, but in the specification at [0043] and in Figure 3.

Pursuant to M.P.E.P. § 706.07(b):

The claims of a new application may be finally rejected in the first Office action in those situations where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) ***all claims of the new application (1) are drawn to the same invention claimed in the earlier application***, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. M.P.E.P. § 706.07(b) (emphasis added).

Because the claims in the Amendment filed May 2, 2005, contained a previously unexamined limitation, the claims in the Amendment filed May 2, 2005, are **NOT** "drawn to the same invention claimed in the earlier application".

Thus, making the first Office action following the Amendment filed May 2, 2005, a final rejection is improper.

Accordingly, Applicants respectfully request that the finality of the Final Rejection dated August 11, 2005, be withdrawn.

The Advisory Action dated February 7, 2006, which improperly refused to withdraw the Final Rejection, ignores the Manual of Patent Examining Procedure (i.e. M.P.E.P.) and asserts:

FAFR practice may be done when the claims of the new application are similar to those of an earlier application filed by the same applicant, and if the claims of the earlier application were rejected on the grounds which are also applicable against the claims of the new application. For example, if the claims of a continuation application are, **in the examiner's opinion**, met by the art of record of the parent application, the examiner may make the rejection final in the first action of the continuation. In re Bogese (ComrPats) 22 USPQ2d 1821 (10/4/1991). In the instant case the claims were drawn to the same invention of a hole forming tool and rejected on the same grounds. As such the finality of the previous office action is deemed proper. (Emphasis added.)

The Examiner's reliance on In re Bogese is misplaced. As shown in In re Bogese (copy attached), the FAFR practice asserted in the Advisory Action was eliminated in 1969.

Following this is the first reference to the application of FAFR practice to continuations. Wolcott, *Manual of Patent Office Procedure*, p. 199 (7th ed. 1936):

Where an application has been prosecuted to a final rejection an applicant may have recourse to filing a continuation in order to introduce into the case a new set of claims and to establish a right to further examination by the primary examiner. If the new claims, however, are **in the opinion of the examiner** met in the art of record in the original application, the examiner may make his rejection on the first action on the continuation. ...

The first edition of the MPEP, MPEP § 706.07(b) (November 15, 1949) states:

**706.07(b) Final Rejection, When Proper on First Action**

In certain instances, the claims of a new application may be finally rejected in the first action. This may be done when the claims of the new application are similar to those of an earlier application filed by the same applicant, and if the claims of the earlier application were rejected on the grounds which are also applicable against the claims of the new application. Such procedure is quite consistent with the provisions of Rule 113, since the action on the claims in the new application is, in effect, a "re-examination" or a "reconsideration" of claims which had been treated previously in the earlier application.

For example, if the claims of a continuation application are, **in the examiner's opinion**, met by the art of record of the parent application, the examiner may make the rejection final in the first action on the continuation. If the rejection is based on *res judicata*, however, it may not be made final in the first action, since this would constitute a new ground of rejection.

Reference to MPEP § 706.07(b) is found in McCrady, *Patent Office Practice* Sec. 166 (3d ed. 1950 and 4th ed. 1959).

***FAFR practice was modified*** by 861 Off. Gaz. Pat. Office 1011 (April 22, 1969), which was superceded by 932 Off. Gaz. Pat. Office 760 (March 18, 1975):

The claims of a new application may be finally rejected in the first Office action in those situations where (1) the new application is a continuing application of, or a substitute for, an earlier application, and (2) ***all claims of the new application (a) are drawn to the same invention claimed in the earlier application***, and (b) would have been properly finally rejected on the ground of [sic of] art of record in the next Office action if they had been entered in the earlier application. ...

**This embodiment of FAFR practice is found in MPEP § 706.07(b).**  
***In re Bogese***, 22 USPQ2d 1821, 1825-1826 (Dec. Comm'r Pat., 1991)(Bold and bold italics added).

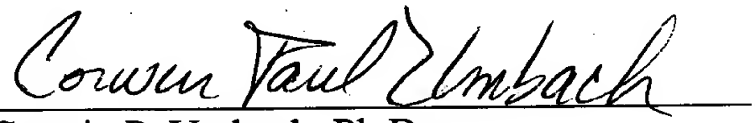
In refusing to withdraw the finality of the Final Rejection dated August 11, 2005, the Examiner refused to follow both *In re Bogese* and M.P.E.P. § 706.07(b).

In accordance with M.P.E.P. § 706.07(b), Applicants respectfully petition that the finality of the Final Rejection dated August 11, 2005, be withdrawn.

If this petition to withdraw the finality of the Final Rejection dated August 11, 2005, is granted, then Applicants further petition that the Patent Office refund to deposit account number 15-0030 the fee for filing a Notice of Appeal of \$500.00 that Applicants paid when filing this petition on February 13, 2006.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.  
Norman F. Oblon

  
Corwin P. Umbach, Ph.D.  
Registration No. 40,211

Attached:

In re Bogese, 22 USPQ2d 1821 (Dec. Comm'r Pat., 1991)

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issue, *Folio Impressions*, 937 F.2d at 765.

To that end, we determine in most cases whether "the ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and regard their aesthetic appeal as the same." *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 [124 USPQ 154] (2d Cir. 1960). However, where a design contains both protectible and unprotectible elements, we have held that the observer's inspection must be more "discerning," ignoring those aspects of a work that are unprotectible in making the comparison. *Folio Impressions*, 937 F.2d at 765-66.

The district court applied the more discerning ordinary observer test for substantial similarity of *Folio Impressions*, concluding that this was the appropriate test because only the shapes of the HAPPY CUBE puzzle pieces are protected by Laureyssens' copyrights. In doing so, the district court excluded from its consideration of substantial similarity the fact that both sets of designs involve "a hollow cube puzzle formed from six pieces with rectilinear interlocking projections which can also be assembled into a flat three-piece-by-two-piece form."

[6] Laureyssens argues that it was clearly erroneous for the district court to exclude any portion of the Laureyssens design because Laureyssens created the puzzles independently, thereby rendering the entire puzzle design "original" under the standard of *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 111 S. Ct. 1282, 1287 [18 USPQ2d 1275] (1991). We disagree. "[T]he protection granted to a copyrightable work extends only to the particular expression of an idea and never to the idea itself." *Durham Industries, Inc. v. Tomy Corp.*, 630 F.2d 905, 912 [208 USPQ 10] (2d Cir. 1980) (quoting *Reyher, v. Children's Television Workshop*, 533 F.2d 87, 90 [190 USPQ 387] (2d Cir.), cert. denied, 429 U.S. 980 [192 USPQ 64] (1976)); see also *Rogers*, slip op. at 2619 [22 USPQ2d 1492]. In the case at hand, in order to express the idea of a perfect hollow cube puzzle that can also be assembled in flat form, a designer must use pieces that interlock through fingers and notches cut at right angles. Indeed, Idea Group presented evidence of two different patents that were obtained for flat-to-cube puzzles in 1974 and 1975; both were created prior to Laureyssens' work. Therefore, we think the district court was correct in concluding that the Laureyssens copyright extends only to his particular expression of the idea of a flat-to-cube puzzle, manifested in the particular shapes of his puzzle pieces. Cf. *Mattel, Inc. v. Azrak-Hamway Intern., Inc.*, 724 F.2d

the copyright did not protect the particular depiction of the flag, we certainly think the observer would conclude that the allegedly infringing jigsaw puzzle was simply a different expression of the idea of a jigsaw puzzle.

Our belief that the SNAFOOZ puzzles are not unlawful appropriations of the HAPPY CUBE designs is reinforced by the testimony of the graduate student who designed the SNAFOOZ puzzles. He stated in his affidavit that he generated a computer program from scratch to create flat-to-cube puzzles that could also be assembled in multi-piece combinations with six notch-widths per edge. Declaration of Eric Brewer ("I can state without equivocation that I designed the SNAFOOZ Puzzles, along with their solutions and the solutions for all of the complex shapes . . . without any reference to the Five-Segment Puzzles (other than to play with them); I started from scratch.").

For these reasons, we conclude that the district court did not abuse its discretion in deciding that the SNAFOOZ puzzles pose no serious question of unlawful appropriation, and accordingly, of copyright infringement with respect to the protectible elements of Laureyssens' copyrights in his HAPPY CUBE designs.

### III.

We have considered all of the arguments pertaining to the merits in this appeal and cross-appeal of the district court's decision to grant a preliminary injunction, and they offer no basis upon which to sustain the issuance of the preliminary injunction. Accordingly, the district court's decision to grant a preliminary injunction based on trade dress infringement under section 43(a) of the Lanham Act and under the New York common law of unfair competition is reversed, the district court's denial of a preliminary injunction based on copyright infringement is affirmed, and costs are awarded to Idea Group.

Preliminary injunction vacated.

U.S. Patent and Trademark Office  
Commissioner of Patents and Trademarks

In re Bogese

Serial No. 07/626,406

Decided October 4, 1991

Released January 22, 1992

## PATENTS

### 1. Practice and procedure in Patent and Trademark Office — Prosecution — Rules and rules practice (§110.0905)

### Practice and procedure in Patent and Trademark Office — Prosecution — Applications for patent (§110.0916)

Patent examiner did not err by determining that applicant's failure to respond to merits of any of five previous Patent and Trademark Office actions constituted "special, rarely occurring circumstance" and warranted, pursuant to Manual of Patent Examining Procedure 710.02(b), establishing shortened 30-day period for response to first action final rejection, since failure to respond on merits justifies setting of shortest response time possible, in order to protect public interest in efficient examination and quick dissemination of information regarding inventions.

### 2. Practice and procedure in Patent and Trademark Office — Prosecution — Rules and rules practice (§110.0905)

### Practice and procedure in Patent and Trademark Office — Prosecution — Applications for patent (§110.0916)

First action final rejection practice, which provides for final rejection on first Patent and Trademark Office action in continuation application under certain circumstances, is entitled to presumption of correctness, since it is in accordance with statutory objective of reducing delay in prosecution, since it is traceable as far back as 1923 and has existed on continuous basis since then, and since it was crystallized in PTO practice, pursuant to Manual of Patent Examining Procedure 706.07(b), at time of enactment of 35 USC 120, which codified existing law of continuations.

Application for patent filed Dec. 14, 1990, by Stephen B. Bogese, serial no. 07/626,406. On petition requesting that 30-day response period as set in Patent and Trademark Office action be reset to three-month period, that finality of office action be withdrawn, and that requirements of 37 CFR 1.111 be waived. Petition denied.

Saidman Designlaw Group, Washington, D.C., for applicant.

Van Horn, administrator, patent policy and programs.



This is a decision on the petition under 37 CFR § 1.182 and 1.183, filed July 25, 1991. The petition requests: (1) that the thirty (30) day response period set in the February 21, 1991, Office action be reset to the normal three (3) month period for response; (2) that the finality of that Office action be withdrawn; and (3) that the requirements of 37 CFR § 1.111 be waived. The petition is denied.

## BACKGROUND

A first patent application was filed on August 26, 1986. A non-final first Office action was mailed March 25, 1987. No response by applicant was filed; consequently this application became abandoned.

A first File-Wrapper-Continuation (FWC) application was filed on September 25, 1987. A non-final first Office action was mailed March 7, 1988. No response by applicant was filed; consequently this application became abandoned.

A second FWC application was filed on September 7, 1988. A non-final first Office action was mailed January 23, 1989. No response by applicant was filed; consequently this application became abandoned.

A third FWC application was filed on July 24, 1989. A final first Office action was mailed October 3, 1989. No response by applicant was filed; consequently this application became abandoned.

A fourth FWC application was filed on April 3, 1990. A final first Office action was mailed June 18, 1990. No response by applicant was filed; consequently this application became abandoned.

This fifth FWC application was filed on December 14, 1990. A final first Office action was mailed February 21, 1991. This Office action set a thirty (30) day shortened statutory period for response.

On June 21, 1991, applicant filed a three month extension of time and a response directed to the finality of the Office action, the thirty (30) day period for response, and paragraph 12 of the Office action.

On June 26, 1991, a timely Notice of Appeal<sup>1</sup> as filed.

On July 15, 1991, the examiner adhered to the finality of the Office action, adhered to the propriety of the thirty (30) day period for response and held that the response did not comply with 37 CFR § 1.111 since the re-

<sup>1</sup> The Notice of Appeal contains a 37 CFR § 1.8 Certificate of Mailing dated June 24, 1991 (a Monday) making the notice timely.

stance present in this application is the fact that applicant has never responded to the merits of any of the five (5) previous Office actions. This failure to respond on the merit justifies the setting of the shortest response time possible (e.g., thirty (30) days). Furthermore, the setting of such a short response time is not punishment for filing a series of continuations but is due to applicant's failure to ever respond to the merits of any Office action. There is a public interest in efficient examination and quick dissemination of information about the invention to the public.

## II. FIRST ACTION FINAL REJECTION

### INTRODUCTION

First action final rejection (FAFR) practice provides for making a final rejection on the first action in a continuation application under certain circumstances. *Manual of Patent Examining Procedure* § 706.07(b) (5th ed., Rev. 13, Nov. 1989).

The legality of FAFR practice was challenged as being contrary to 35 U.S.C. § 132, which requires an examination and a reexamination, in a mandamus action to enter an amendment after a first action final rejection in *Molins PLC v. Quigg*, 4 USPQ2d 1646 (D.D.C. 1987). The issue was not decided as the case was dismissed on the grounds of mootness. The Federal Circuit affirmed the district court decision for lack of ripeness without reaching the mootness issue. *Molins PLC v. Quigg*, 837 F.2d 1064, 5 USPQ2d 1526 (Fed. Cir.), cert. denied, 486 U.S. 1055 (1988).

We use this petition decision as an opportunity to set forth the history and reasons for FAFR practice. The following background will be useful in explaining the practice.

### HISTORY

#### Delays in obtaining a patent

The intent of the various patent statutes has always been to grant patent rights for a limited time. U.S. Constitution, Article I, Section 8. The law has not approved delays before filing and during pendency which extend the period of patent rights. *Woodbridge v. United States*, 263 U.S. 50, 56 (1923).

Any practice by the inventor and applicant for a patent through which he deliberately and without excuse postpones beyond the date of the actual invention, the beginning of the term of his monopoly, and

thus puts off the free public enjoyment of the useful invention, is an evasion of the statute and defeats its benevolent aim.

A history of the problems arising from delays in obtaining patents and statutory solutions is found in Seegrist, *Delay in Claiming*, 21 J. Pat. Off. Soc'y 741 (1939); *Changes in the Patent Laws*, 21 J. Pat. Off. Soc'y 703 (1939); and Byers, *The Selden Case*, 22 J. Pat. Off. Soc'y 719 (1940).

FAFR practice was originally applied to reduce delay in connection with renewal applications. The practice was later extended to continuations because of the similar nature of the problem.

#### Continuation applications

The practice of filing continuing applications arose early in Office practice mainly as a procedural device. Section 7 of the Patent Act of 1836, Ch. 357, § 5 Stat. 117 (July 4, 1836), provided that an inventor whose application was refused could request reconsideration, with or without amendment, or could withdraw the application and receive a refund of \$20 of the \$30 initial fee. This section was the origin of the present 35 U.S.C. § 132. Because of early Office rules prohibiting amendments changing the nature of the invention, there began a practice where the applicant, instead of amending the application after a rejection, would withdraw the application and file new papers and a new filing fee. See Seegrist, 21 J. Pat. Off. Soc'y 759-60; Deller, *Walker on Patents*, § 178 (1937) (on the basis for the right to amend).

The concept of a continuation application grew out of this practice and was first recognized in *Godfrey v. Eames*, 68 U.S. (1 Wall.) 317, 325-26 (1864):

if a party choose to withdraw his application for a patent, and pay the forfeit, intending at the time of such withdrawal to file a new petition, and he accordingly do so, the two petitions are to be considered as parts of the same transaction, and both as constituting one continuous application, within the meaning of the law. (Emphasis added.)

A history of continuations beginning with *Godfrey v. Eames* is found in 4 Chisum, *Patents* § 13.02 (1990). The continuation practice was codified in 35 U.S.C. § 120 in 1952. *In re Hogan*, 559 F.2d 595, 603, 194 USPQ 527, 535 (CCPA 1977).

We preview FAFR practice by observing that it is based on the *Godfrey v. Eames* concept of a continuation application and the original as part of "the same transaction" and "as constituting one continuous application."

#### Renewal applications

FAFR practice first arose in connection with the now-abolished practice of renewal applications. The history of renewal applications is described at 21 J. Pat. Off. Soc'y at 707-710. Briefly, in 1861 the fee system was changed to a two-part system of application filing fee and final issue fee. In 1865 the renewal application was created to provide for obtaining a patent when the time for payment of the final fee had lapsed.

When an application was allowed, an applicant had six months to pay the final issue fee or the application would be "forfeited." The Commissioner had no authority to accept a late fee or extend the six-month period, but a forfeited application could be "renewed" as a matter of right by filing a renewal application within two years (changed to one year in 1927) from the date of allowance. Renewals were considered continuances of the original application for substantive purposes under the reasoning of *Godfrey v. Eames*, *Detroit Iron & Steel Co. v. Carey*, 236 F. 924 (6th Cir. 1916), cert. denied, 242 U.S. 649 (1917).

Renewals were used for two functions, as described at 21 J. Pat. Off. Soc'y at 710:

The historical function of renewals was to provide for the obtaining of a patent when the time for payment of the final fee had been permitted to lapse through accident or unavoidable delay. . . .

The second function of renewal applications was perhaps accidental, due to the peculiar manner in which the first purpose was accomplished by the statute. This second use of renewals was to prolong and delay the issuance of a patent by starting the proceedings all over again, aside from the necessary delay in going through the routine or the statute. The statute being worded in terms of a new application for a patent being filed, additional claims and claims to additional subject matter could be presented in the new application, which required a new examination. It is well known that in many instances final fees were deliberately withheld so that a renewal application could be filed for this purpose.

This use for delay was a primary reason for the elimination of renewal applications in 1939 in favor of the method of petition to the Commissioner for delayed payment of the fee.

The same type of delay is still possible with continuation applications since it is permissible to file a continuation application of an allowed application. *In re Febrey*, 135 F.2d 751, 57 USPQ 407 (CCPA 1943); *Harder v. Haywood*, 150 F.2d 256, 66 USPQ 51 (CCPA 1945).

## FIRST ACTION FINAL REJECTION PRACTICE

### Ex parte Ball

The first statement of FAFR practice is contained in *Ex parte Ball*, 1924 C.D. 123, 124 (Comm'r Pat. 1923):

A renewal application is a continuance of the original application. *Detroit Iron & Steel Co. v. Carey*, 236 Fed. Rep. 924. They are now given the same serial number in the Office (304 O.G. 629).

Consequently the prosecution, before and after renewal, including the Office actions, must be considered a continuous proceeding, and a final rejection, if properly based on previous rejections, may be correct, even if it constitutes the first Office action after renewal.

The final rejection in the case was, however, given in the second action. The concern with intentional delay by the applicant is stated, 1924 C.D. at 125:

The applicant has waited his full year practically in responding to nearly every Office action, besides allowing the case to become forfeited and using the full statutory two years in renewing. Of the 10 years and more this application has been pending delay on his part amounts to seven years besides the renewal period. Under these circumstances an endeavor on the part of the applicant to find cause whereby final action should be further postponed deserves careful scrutiny.

### Rationale

FAFR practice was not considered to conflict with the provisions of Revised Statute § 4903 (1874), which became the present 35 U.S.C. § 132, requiring an examination and a reexamination. The renewal application was treated as part of one continuous transaction with the original under *Godfrey v. Eames* and was considered by the Office to be a new application in form only. The statutory requirement for an examination was met by the examinations in the original application, and the requirement for a reexamination is met by the examination of the renewal.

In accordance with statutory intent, one objective of Office practice has been to reduce delays in the prosecution of applications. FAFR practice served that objective by forcing an applicant to draft claims in the renewal in view of the prosecution history in the original and make a bona fide effort to define issues for appeal or allowance. FAFR practice denied dilatory applicants the delay

advantage inherent in another Office action. In 1923 this delay amounted to a one year response period plus the time required by the Office. The only possible harm was the price of a new filing fee.

The same reasoning extends to continuation applications to which FAFR practice was applied in the 1930s. Continuances are part of a continuous application with the original, and the examinations in the original can be considered the first examination and the examination in the continuation as the reexamination. For this reason, FAFR practice is not considered to violate 35 U.S.C. § 132. FAFR practice serves the function of reducing delay by forcing an applicant to draft claims in the continuation in view of the prosecution history in the original. Under present FAFR practice, an applicant can submit an amendment after final rejection or closing of the prosecution in the original application and, if it is denied entry because it presents new issues or raises an issue of new matter, the continuation cannot be made final on the first action. MPEP § 706.07(b). This practice seeks to refine the issues to the point of allowance or appeal in the original without the delay of a continuation.

### Recognition of FAFR practice

The first reference to FAFR practice is found in McCrady, *Patent Office Practice* (1928), Sec. 279:

On the theory that a renewal is a continuance of the original application, a final rejection based on an Office action previous to renewal and constituting the first Office action after renewal was indicated as permissible in *ex parte Ball*, 329 O.G. 4; 1924 C.D. 123, although the final rejection in that case was made in the second action after renewal.

The FAFR practice was mentioned in Newton, *Final Rejections and Subsequent Practice*, 11 J. Pat. Off. Soc'y 390, 401 (1929):

A renewal application was held in *Ex parte Ball*, *supra*, to be a continuance of the original case, and claims presented therein should be drawn in view of the art of record in such original case. In the application on which the decision cited was based, claims were presented on renewal which read on a reference of record in the original papers. A final rejection in the first Office action after renewal was held proper.

The next reference we find is Stringham, *Patent Soliciting and Examining* (1934), Sec. 172, which was incorporated and added to in Glascock & Stringham, *Patent Soliciting and Examining* (1934), Sec. 172:

SEC. 172. It has been said that a renewed application may be finally rejected on the first action.

Ball, 1924 CD 123; 329 OG 4  
Kaisling (2518), 18 CCPA 740; 44 F(2d) 863; 1931 CD 35; 7 USPQ 134; 402 OG 265; 5 Daily 3218  
Prouty, 1919 CD 62; 264 OG 533

In the *Ball* application Commissioner Robertson said that "a final rejection, if properly based on previous rejections, may be correct, even if it constitutes the first action after renewal." In that case, however, the final rejection had been given in the second action.

The dual character of a renewed application as a new application and as a continued prosecution of an old one gives rise to a question of the propriety of a final rejection on the first action when the same rejection has been made in the original application.

A renewal is, in at least some aspects, a new application (*Prouty*) and 35 USCA 51, RS 4903 gives applicants the right to a reexamination after the first rejection. Therefore the court might mandamus the commissioner to give the second action, or on the contrary, it might agree with the commissioner that a renewal is a new application in form only, and since final rejection upon the old record could do no substantial injury, it would, therefore, refuse to interfere. Until the question of final rejection on the first action after renewal actually arises, it may be regarded as somewhat doubtful, but meanwhile the opinion which the commissioner has expressed would justify an examiner in making a rejection final in a clear case.

The *Kaisling* decision discussed in section 277 modifies *Prouty* and seems to strengthen the position of Commissioner Robertson quoted above [section 277, however, comments: "[t]he *Kaisling* decision has been nearly if not quite repudiated by *Doherty v. Dubbs*, [68 F.2d 373, 20 USPQ 145 (CCPA 1934)] which appeared while the present book was in press"].

Following this is the first reference to the application of FAFR practice to continuations. Wolcott, *Manual of Patent Office Procedure*, p.199 (7th ed. 1936):

Where an application has been prosecuted to a final rejection an applicant may have recourse to filing a continuation in order to introduce into the case a new set of claims and to establish a right to further examination by the primary examiner. If the new claims, however, are in the opinion of the examiner met in the art of record in



the original application, the examiner may make his rejection final on the first action on the continuation.

The same language appears in the 8th edition (1940) and 9th edition (1946). The *Manual of Patent Office Procedure* was published by the Patent Office Society and was the forerunner of the present PTO *Manual of Patent Examining Procedure* (MPEP).

The following statement in 1939 is found in Seegrist, 21 J. Pat. Off. Soc'y at 760:

Use is today seldom made of the device of filing a pure continuation to effect delay. The Office treats the new application as a continued prosecution and does not hesitate to give a final rejection in the first action based on the prosecution of the parent application. It is customary, however, to give at least one action on the merits in the continuation.

The first edition of the MPEP, MPEP § 706.07(b) (November 15, 1949) states: 706.07(b) Final Rejection, When Proper on First Action

In certain instances, the claims of a new application may be finally rejected in the first action. This may be done when the claims of the new application are similar to those of an earlier application filed by the same applicant, and if the claims of the earlier application were rejected on the grounds which are also applicable against the claims of the new application. Such procedure is quite consistent with the provisions of Rule 113, since the action on the claims in the new application is, in effect, a "re-examination" or a "reconsideration" of claims which had been treated previously in the earlier application.

For example, if the claims of a continuation application are, in the examiner's opinion, met by the art of record of the parent application, the examiner may make the rejection final in the first action on the continuation. If the rejection is based on *res judicata*, however, it may not be made final in the first action, since this would constitute a new ground of rejection.

Reference to MPEP § 706.07(b) is found in McCrady, *Patent Office Practice* Sec. 166 (3d ed. 1950 and 4th ed. 1959).

FAFR practice was modified by 861 Off. Gaz. Pat. Office 1011 (April 22, 1969), which was superseded by 932 Off. Gaz. Pat. Office 760 (March 18, 1975):

The claims of a new application may be finally rejected in the first Office action in those situations where (1) the new application is a continuing application of, or a substitute for, an earlier application, and

(2) all claims of the new application (a) are drawn to the same invention claimed in the earlier application, and (b) would have been properly finally rejected on the grounds or [sic of] art of record in the next Office action if they had been entered in the earlier application.

However, it would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry for one of the following reasons:

(1) New issues were raised that required further consideration and/or search, or

(2) The issues of new matter was raised. Further, it would not be proper to make final a first Office action in a continuation-in-part application where any claim includes subject matter not present in the earlier application.

A request for an interview prior to first action on a continuing or substitute application should ordinarily be granted.

This embodiment of FAFR practice is found in MPEP § 706.07(b).

# APPLICANT'S ARGUMENT

Applicant submits that since he did respond on the merits to the first (non-final) Office action in the parent case, but instead filed a continuation application, a final rejection on the first action in this application is improper. Before a final rejection is proper, a "clear issue" must be developed between the examiner and the applicant.

Section 706.07 of the MPEP states that: before final rejection is in order a *clear issue* should be developed between the examiner and the applicant. . . . present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his or her invention and claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut-off in the prosecution of his or her case. . . .

The examiner should never lose sight of the fact that in every case the applicant is

<sup>1</sup> The first Office action in the parent application was a *final* rejection. See background section.

entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.

MPEP § 706.07 (emphasis added). Applicant submits further that, here, the examiner rejected the continuation application on the identical grounds as that in the parent application, but this time made the action final, and that, in fact, the examiner's first final Office action in the continuation case was identical to the first non-final Office action in the parent case. Applicant submits that due process and fair play require him to be given at least one opportunity to substantively, as a matter of right, respond to the examiner's rejection. Needless to say, if the "final" nature of this action is maintained, applicant has no such right and that without such an opportunity, applicant is prematurely cut-off in the prosecution of this case and has been denied a full and fair hearing for which he has paid a full filing fee.

Applicant urges that the examiner's practice of issuing a first action final rejection is deemed proper, where applicant has never amended the claims or added new claims or filed a substantive response to the examiner's rejections, it would effectively deny applicant the right to file in this application a response on the merits and to have the PTO reexamine this application as guaranteed by 35 U.S.C. § 132. Applicant urges that if the final rejection stands, the only option open to applicant to prosecute the instant claims is to refile yet another FWC application together with a Preliminary Amendment, but that such a procedure, while certainly possible, denies applicant the right to have his claims examined and reexamined in this application, as set forth in 35 U.S.C. §§ 131 and 132. Applicant submits that the underlying rationale for first action final rejections, having to do with unentered amendments as set forth in MPEP § 706.07(b), is totally inappropriate in this case.

## DECISION

[2] Continuances arose after the establishment of an examination system requiring an examination and a reexamination. Continuances, as created by court decision, were considered as part of a continuous proceeding with the original FAFR practice, as applied to renewals and then to continuations, relied on the concept of a continuous proceeding to require applicants to consider

<sup>1</sup> *Id.*

the prosecution history in the original when filing a renewal or continuation. The practice is in accordance with the statutory objective of reducing delay in prosecution. FAFR practice is traceable as far back as 1923 and has existed on a continuous basis until the present date. FAFR practice was crystallized in Office practice in MPEP § 706.07(b) at the time the present 35 U.S.C. § 120 was enacted in 1952; it must be assumed that legislators were aware of the practice. Section 120 codified the existing law of continuations. Under the circumstances, the practice is entitled to a presumption of correctness.

As to the facts of this case, it is noted that applicant has not been denied the right to respond. In fact, applicant has chosen not to respond on the merits to any Office action during the prosecution of six (6) separate applications drawn to the same invention. While applicant has no right to amend the claims after final Office action (see 37 CFR § 1.116), the examiner has the discretion to enter such an amendment but has never been given the opportunity to exercise that discretion due to applicant's decision not to respond to the substance of any examiner's action.

In view of the above, the finality of the February 21, 1991, Office action will not be withdrawn.

## III. WAIVER OF 37 CFR § 1.111

### APPLICANT'S ARGUMENT

Rule 111 requires that a response to an examiner's action reply to all grounds of rejection or be considered non-responsive.

To impose this requirement in this case without deciding the two issues being petitioned herewith would be unduly harsh. One of the issues on petition is whether the examiner's first action is properly "final." If it is deemed that it is, then there is no sense in applicant submitting amendments and/or arguments at this stage since any amendment or argument, being the first submitted in this application, would raise new issues or require further consideration. Thus, once applicant submits such amendments and arguments, the examiner would properly (assuming the final rejection were proper) deny them entry, rendering applicant's effort useless. On the other hand, if applicant can get a determination on this petition that the examiner's first action final rejection is indeed out of order and the action is reissued as a non-final first action, then applicant's submission of an amendment and argument

would not be a useless act. To enforce Rule 111 now, however, would exalt form over substance and it should, therefore, be waived while these two important procedural issues are decided.

#### DECISION

The requested waiver of 37 CFR § 1.111 is denied as moot since a proper response (e.g., a Notice of Appeal) to the final Office action was timely filed. However, applicant should note that the mere filing of a petition will not stay the period for response to an Office action. 37 CFR § 1.181(f). In any event, the propriety of the thirty (30) day response period and the finality of the Office action have been decided above.

#### SUMMARY

The petition to reset the thirty (30) day period for response to three (3) months is **DENIED**.

The petition to withdraw the finality of the Office action is **DENIED**.

The petition to waive 37 CFR § 1.111 is **DENIED**.

#### NOTICE

Applicant is advised that if another continuing application is filed, without a substantive response to advance prosecution, that the claims of that application may be rejected under the equitable doctrine of laches.

The doctrine of laches, meaning undue delay in claiming one's rights, may result in loss of those rights. In this case the loss may be the right to a priority date, or the right to a patent.

The case record shows a plurality of continuations with no substantive response of any kind to advance prosecution, which in effect may be using the Patent and Trademark Office and patent laws as a means for officially suppressing any invention disclosed but not yet claimed, thereby obtaining inequitable benefits through the patent system.

Prompt disclosure to the public, with no undue delay, is required for consideration for a patent grant. See *Ex parte Hull*, 191 USPO 157 (Bd. App. 1975).

Applicant is further advised that continued failure to prosecute (e.g., respond to all the rejections set forth by the examiner) may be considered to be a special circumstance under 35 U.S.C. § 122 that would cause the Commissioner to publish or otherwise make

the subject matter of this application available to the public.

#### FURTHER PROCESSING

The application is being forwarded to Group 210 to await the filing of applicant's appeal brief.

U.S. Patent and Trademark Office  
Commissioner of Patents and Trademarks

In re Fressola

No. 07/230,748

Decided February 18, 1992

Released April 27, 1992

#### PATENTS

1. Practice and procedure in Patent and Trademark Office — Prosecution — Rules and rules practice (§110.0905)

Provision of Manual of Patent Examining Procedure is lawful if rule or procedure in question is within Patent and Trademark Office's statutory authority, if it is reasonably related to purposes of enabling legislation, and if it does not violate due process.

2. Practice and procedure in Patent and Trademark Office — Prosecution — Rules and rules practice (§110.0905)

Practice and procedure in Patent and Trademark Office — Prosecution — Applications for patent (§110.0916)

Practice and procedure in Patent and Trademark Office — Commissioner — Authority (§110.1909)

Manual of Patent Examining Procedure's requirement, MPEP 608.01(m), that claim be written as single sentence is within statutory authority of Patent and Trademark Office and is consistent with statutory purpose of 35 USC 112, second paragraph, since Section 112 does not specify mode of claiming and PTO thus has authority to require that certain form be followed in interest of efficient administration, since PTO practice has required single sentence claiming, either implicitly or explicitly, for last 155 years, since rules of practice, including MPEP's explicit single sentence claiming requirement, were established pursuant to statutory authority and thus are presumed to be consistent with law, since single sentence claim form is universally recognized by patent au-

thorities as accepted form under PTO practice, and since allowance of multiple sentence claims would destroy uniformity of practice concerning claim drafting and interpretation which has developed around single sentence format over 155-year period.

3. Practice and procedure in Patent and Trademark Office — Prosecution — Rules and rules practice (§110.0905)

Practice and procedure in Patent and Trademark Office — Prosecution — Applications for patent (§110.0916)

"Objection" to claim not drafted in single sentence form required by Manual of Patent Examining Procedure Section 608.01(m) did not result in effective rejection of claim by examiner, since single sentence requirement is formal matter which does not interfere with applicant's substantive right of expression, and since claim in question is capable of being redrafted as single sentence without loss of meaning.

4. Practice and procedure in Patent and Trademark Office — Prosecution — Rules and rules practice (§110.0905)

Practice and procedure in Patent and Trademark Office — Prosecution — Applications for patent (§110.0916)

Manual of Patent Examining Procedure's requirement, MPEP 608.01(m), that claim be written as single sentence is not ultra vires, even though such requirement is not found in 35 USC 112 or 37 CFR 1.75, since single sentence requirement has not been shown to be inconsistent with relevant statute, rules, or case law of PTO's reviewing court, nor is such requirement contrary to public notice goal of patent laws, even though complexity of long single sentence claims has been recognized, since multiple sentence claims are not inherently more clear than single sentence claims, and since requirement promotes clarity and precision in definition of invention by eliminating verbiage needed for multiple complete sentences.

Patent application of Alfred A. Fressola, serial no. 07/230,748, filed Aug. 10, 1988. From examiner's objection to claims 19-21 for having multiple sentences, applicant petitions for withdrawal of objection and modification of Manual of Patent Examining Procedure Section 608.01(m) to permit multiple-sentence claims. Denied.

Alfred A. Fressola, of Mattern, Ware, Stoltz & Fressola, Fairfield, Conn., for petitioner.

Manbeck, commissioner of patents and trademarks.

This is a decision on a petition under 37 CFR § 1.181, filed October 19, 1990, to withdraw the objection of claims 19-21 for having multiple sentences and to modify the Manual of Patent Examining Procedure (MPEP) § 608.01(m) to permit multiple sentence claims.

The petition is denied.

#### BACKGROUND

Independent claim 19 was objected to as written in the form of nine individual sentences rather than as a single sentence required by the Patent and Trademark Office (PTO) under MPEP § 608.01(m) (5th ed., Rev. 13, Nov. 1989). Claims 20 and 21 are written in single sentence form but are dependent upon claim 19 and, therefore, were similarly objected to.

Petitioner contends that MPEP § 608.01(m) has no basis in Title 35 of the United States Code or in Title 37 of the Code of Federal Regulations to prohibit the allowance of a claim having multiple sentences.

#### OPINION

[1] The statutory requirement for claims is contained in 35 U.S.C. § 112, second paragraph, which states that

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The statute does not prescribe a set claim form; nor is a set claim form required by 37 CFR § 1.75. The single sentence claim requirement of MPEP § 608.01(m) is a matter of form under PTO practice. In reviewing the lawfulness of MPEP provisions, as stated in *Patlex Corp. v. Mossinghoff*, 758 F.2d 594, 606, 225 USPQ 243, 252, modified, *reh'g granted in part*, 771 F.2d 480, 226 USPQ 985 (Fed. Cir. 1985):

The PTO operates in accordance with detailed rules and regulations, including those set out in the Manual of Patent Examining Procedure (MPEP) which is made available to the public and which has been held to describe procedures on which the public can rely. *In re Kagan*,